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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/684,126
Filing Date: October 06, 2000
Appellant(s): HULL ET AL.

Justin D. Petruzzelli
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 12/20/06 appealing from the Office
action mailed 05/23/06.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6,621,590	Livingston	09/2003
5,694,610	Habib et al.	12/1997
6,262,732	Coleman et al.	07/2001
5,600,412	Connors	02/1997

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary.

Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 56, 59-62, 65-68, 70 and 76-82 are rejected under 35 U.S.C. 103(a) as being unpatentable over Livingston [US. 6,621,590] in view of Habib et al. [US. 5,694,610] and further in view of Coleman et al. [US. 6,262,732].

As per independent claims 56, 62, 68 and 70, Livingston teaches a computer implemented method and corresponding system for controlling through a graphic user interface the printing of a document having one or more pages, wherein each of the plurality of pages has associated therewith a plurality of media and/or finishing attributes, comprising the steps/means: a page representation for each of the plurality of pages (68 and 84 of fig. 3A) although the multiple pages are not simultaneously displayed.

Livingston further teaches a media and/or finishing attributes operator interface operatively coupled to a selected group of the plurality of pages and configured to facilitate at least one of viewing of adding, deleting to, and modifying of the media and/or finishing attributes of the selected group of the plurality of pages (Livingston, 64 and 58 of fig. 3A; col. 5, lines 29-50).

Although Livingston teaches the media and finishing attributes operator interface, Livingston fails to clearly teach or suggest "the media and/or finishing attributes operator interface operatively coupled to the page of the plurality of pages being displayed in response to selections of the page representations for

the selected page of the plurality of pages". Livingston fails to teach the step of "right-click" the mouse.

However, Habib et al. teach the feature at figure 3C, when the operator wishes to view the page features which have been applied to the page (3C04), he/she selects the page by right-click the mouse. Once selected, a menu (3C05) can be viewed of the various available page features for modifying the page (3C04).

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to combine the teaching of Habib with Livingston's system. Motivation would have been to enhance the printing page representations.

Furthermore, Livingston in view Habib do not disclose the page representations being miniature representations of particular pages as they will look when they are printed and the GUI displays more than one page representation simultaneously. Coleman disclose a plurality of miniature representations of particular pages, as they will look when they are printed, and the GUI displays more than one page representation simultaneously (fig. 2; col. 6, lines 5-15). It would have been obvious to an artisan at the time of the invention to use the teaching from Coleman of displaying a plurality of miniature representations of particular pages, as they will look when they are printed, and the GUI displays more than one page representation simultaneously in to combine the systems of Livingston in view of Habib. Motivation would have been to allow users quickly to review and to change each individual page's attributes.

As per claim 59, which is dependent claim 56, Livingston fails to clearly teach or suggest “the media and/or finishing attributes operator interface is displayed when the pointing device is manipulated over one of the selected page representations”. However, Habib et al. teach the feature at figure 3C, when the operator wishes to view the page features which have been applied to the page (3C04), he/she selects the page by right-click the mouse. Once selected, a menu (3C05) can be viewed of the various available page features for modifying the page (3C04). It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to combine the teaching of Habib with Livingston’s system.

As per claims 60-61 and 66-67, which are both dependent on claims 56, Livingston does not disclose the media and/or finishing attributes operator interface being comprised of a pull down menu and the media and/or finishing attributes operator interface being comprised of a dialog box. Habib discloses a page setup include a pull down menu and a dialog box (203 of fig. 2). It would have been obvious to an artisan at the time of the invention to use the teaching from Habib of a page setup include a pull down menu and a dialog box in modified Livingston’s system since it would make it easier for users to control the attributes via the pull down menu and dialog box.

As per claim 65, which is dependent on claim 62, it is a similar scope to claim 59; therefore, it should be rejected under similar scope.

As per claims 76 and 79, Livingston teaches or suggests “the media and/or finishing attributes operator interface facilitates viewing of, adding to, and deleting from the media and/or finishing attributes”. Livingston fails to clearly teach the step facilitating these above attributes from the selected group of the plurality of pages.

However, Habib et al. teach the feature at figure 3C, when the operator wishes to view the page features which have been applied to the page (3C04), he/she selects the page by right-clicking the mouse. Once selected, a menu (3C05) can be viewed of the various available page features for modifying the page (3C04). It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to combine the teaching of Habib with Livingston's system.

As per claims 77, 80 and 82, Livingston teaches or suggests “the media and/or finishing attributes operator interface facilitates viewing of, adding to, and deleting from and modifying of the media and/or finishing attributes”. Livingston fails to clearly teach the step facilitating these above attributes from the selected group of the plurality of pages.

However, Habib et al. teach the feature at figure 3C, when the operator wishes to view the page features which have been applied to the page (3C04), he/she selects the page by right-click the mouse. Once selected, a menu (3C05) can be viewed of the various available page features for modifying the page (3C04).

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to combine the teaching of Habib with Livingston's system.

As per claims 78 and 81, Livingston in view Habib do not disclose the selected group of the plurality of pages including all of the plurality of pages. Coleman disclose the features at fig. 2; col. 6, lines 5-15. It would have been obvious to an artisan at the time of the invention to use the teaching from Coleman of displaying a plurality of miniature representations of particular pages, as they will look when they are printed, and the GUI displays more than one page representation simultaneously in to combine the systems of Livingston in view of Habib. Motivation would have been to allow users quickly to review and to change each individual page's attributes.

Claims 72-75 are rejected under 35 U.S.C. 103(a) as being unpatentable over Livingston [US. 6,621,590] in view of Habib et al. [US. 5,694,610] and further in view of Coleman et al. [US. 6,262,732] and further in view of Connors [US 5,600,412].

As per claims 72-75, Livingston in view of Coleman does not disclose the GUI detects conflicts between media and/or finishing attributes and media and/or finishing attributes which are improperly set. Connors discloses that in col. 10, lines 44-47. It would have been obvious to an artisan at the time of the invention to use the teaching from Connors of detecting conflicts between media and/or

finishing attributes and media and/or finishing attributes which are improperly set in modified Livingston's system since it would allow the system to avoid the inadvertently setting conflicts.

(10) Response to Argument

a) Appellant has argued that the combination of the Livingston Patent and the Habib et al. Patent does not teach or suggest an operator interface operatively coupled to a selected group of a plurality of pages. Further, Appellant argues that one skilled in the art knowing that a document can have a plurality of pages according to the Livingston patent and also knowing that page features of a single page can be viewed by right-clicking on the single page according to the Habib et al. patent would not also know that attributes of a group of pages can be viewed and modified by selecting page representations of the groups of pages.

However, the examiner respectfully disagrees with this argument. Appellant is correct in stating that of the combination of Livingston and Habib fails to teach attributes of a group of pages can be viewed and modified by selecting page representations of the groups of pages. The examiner has not relied upon these references to teach these limitations. Rather, the examiner has also relied upon the Coleman et al. patent, which teaches and suggests simultaneously displaying a group of pages. The examiner relied on Livingston, Habib and Coleman for the teaching of all above features in claims 56 and 62. Appellant has not address the rejection as set forth by the examiner.

Livingston teaches a page representation for each of the plurality of pages (68 and 84 of fig. 3A) although Livingston teaches multiple pages but the multiple pages are not simultaneously displayed. Livingston also teaches a media attribute operator interface comprising viewing of adding, deleting to and modifying of the page.

Moreover, Habib teaches "the media and/or finishing attributes operator interface operatively coupled to the page of the plurality of pages is displayed in response to selections of the page representations for the selected page of the plurality of pages". Habib teaches the step of "right-clicking" the mouse by reciting "when the operator wishes to view the page features which have been applied to the page (3C04), he/she selects the page by right click the mouse. Once selected, a menu (3C05) can be viewed of the various available page features for modifying the page (3C04). Further, Coleman discloses displaying simultaneously multiple page representations on a GUI (figure 2). **Thus, one skilled in the art considering the combined teachings of Livingston, Habib and Coleman would know that attributes of a groups of pages can be viewed and modified by selecting page representations of the group of pages.**

b) Appellant has also argued that Livingston patent does not teach allowing a user to view miniature page representations that look like the actual pages when they are printed, so that the user can easily remember what their pages

look like so the user can more easily know what attributes should be applied to which pages. However, the examiner has not relied on Livingston for this feature. The relied upon Coleman patent discloses a plurality of miniature representations of particular pages, as they will look when they are printed, and the GUI displays more than one page representation simultaneously (figure 2, column 16, lines 5-15).

Further, appellant argued that there is no motivation to combine the patents of Livingston and Habib.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

In this case, the examiner respectfully disagrees because both of the references disclose the same field of invention. These references disclose a method for editing and formatting data in a document including displaying a list of selectable features.

Livingston teaches attributes operator interface (menu list) comprising viewing of adding, deleting to and modifying of the page, the patent fails to

clearly teach the step of right clicking the mouse in order to display the attributes operator interface, Habib teaches the step of "right-clicking" the mouse to display the attributes operator interface.

Thus, one skilled in the would need to modify the teachings of the Livingston et al. patent to require the display of a menu by right-clicking the page representation for a benefit of enhancing the representation of the printing page.

Moreover, in view of the guidance provided by the Supreme Court in *KSR* decision, a patent claim is prima facie obvious if "some motivation or suggestion to combine the prior art teachings" can be found in the prior art, the nature of the problem, or the knowledge of a person having ordinary skill in the art. See the recent Board decision *EX parte Smith*, --USPQ2d--, slip op. at 20, (Bd. Pat. App. & Interf. June 25, 2007 (citing *KSR*, 82 USPQ2d at 1396) (available at <http://www.uspto.gov/web/offices/dcom/bpai/prec/fd071925.pdf>)).

c) Appellant argued that the combination of the Livingston patent and the Habib et al. patent does not teach or suggest that simultaneous display of multiple pages representations. Further, appellant states that the scroll bar mechanism 70 shown in figure 3A of the Livingston patent is conducive to the display of only a single page at a time. However, the examiner relied on Coleman for the teaching of the feature of simultaneously displaying of multiple page representations. The examiner has not relied upon these references to teach

the limitation of simultaneously displaying of multiple pages. Rather, the examiner has relied upon the Coleman patent which teaches this limitation. Appellant's argument is not found to persuasive because the appellant has not address the rejection as set forth by the examiner. While Livingston teaches displaying a single page representation, Coleman discloses displaying simultaneously multiple page representations on a GUI (figure 2).

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Mylinh Tran



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